

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

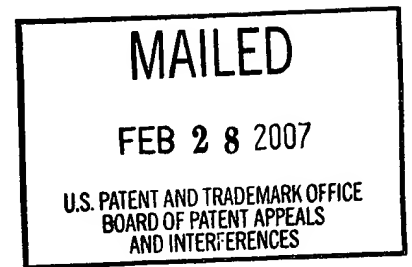
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES M. WHITE

Appeal No. 2007-0167
Application No. 09/596,370

ON BRIEF



Before SCHEINER, MILLS, and GRIMES, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 21-35.

Claim 21 is representative of the claims and reads as follows.

21. A biological fluid disposal system comprising:

a housing;

a water flow line having an inlet and an outlet extending outwardly of said housing;

a biological fluid line in fluid communication with said water flow line, said biological fluid line having an inlet positioned outwardly of said housing; and

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a disinfectant line in fluid communication with said water flow line, said disinfectant line being in valveless fluid communication at a connection point with said biological fluid line within said housing, said disinfectant line having an inlet extending outwardly of said housing, said biological fluid line and said disinfectant line being connected to said water flow line such that solely a flow of water through said water flow line causes a suction action through said biological fluid line and said disinfectant line to draw a biological fluid line through said biological fluid line and draw a disinfectant through said disinfectant line so as to mix the disinfectant with the biological fluid prior to passing into said water flow line, said housing having no pumps therein, the suction action through said disinfectant line being dependent upon flow of said biological fluid.

The prior art cited by the Examiner is:

Aubrey et al. (Aubrey)	3,857,409	Dec. 31, 1974
Jackson	5,087,420	Feb. 11, 1992
Griffiths	5,914,047	Jun. 22, 1999
Kern, Jr. et al. (Kern)	6,000,418	Dec. 14, 1999

Grounds of Rejection

Claims 21-25, 29-31, and 33-34 stand rejected under 35 U.S.C. § 103(a) over Jackson in view of Aubrey and Kern.

Claims 26-28, 32, and 35 stand rejected under 35 U.S.C. § 103(a) over Jackson in view of Aubrey, Kern and Griffiths.

We reverse.

DISCUSSION

35 U.S.C. § 103(a)

Claims 21-25, 29-31, and 33-34 stand rejected under 35 U.S.C. § 103(a) over Jackson in view of Aubrey and Kern. Claims 26-28, 32, and 35 stand rejected under 35 U.S.C. § 103(a) over Jackson in view of Aubrey, Kern and Griffiths.

According to the Examiner, Jackson discloses a method and device for disposal of biological fluids. Answer, page 4. Jackson teaches a disinfectant line in communication with the water flow line such that the disinfectant line has an inlet outwardly of the housing. Id. The Examiner further finds in Jackson that the disinfectant line and the biological fluid line are connected with the water flow line, and the disinfectant line is in valveless fluid communication with the biological fluid line. Id.

The Examiner acknowledges that Jackson fails to teach that "solely the flow of the water causes the simultaneous (i.e., coinciding in time) suction and mixing of both the disinfectant and the biological fluid lines (venturi means) and the housing contains no pumps." Answer, page 5.

The Examiner relies on Aubrey, disclosing a liquid mixing apparatus, for the disclosure of a housing and the removal of "any requirement of having pumps by using the venturi effect (col. 4, lines 43-47, col. 7, lines 64-67 and col. 8, lines 1-6)." Answer, page 5. The Examiner acknowledges in Aubrey "there is no specific teaching that solely the flow of water causes the simultaneous suction and mixing (venturi effect) of

both the disinfectant and the biological fluid lines.” Id. Thus, the Examiner also relies on Kern to “show the concept that the flow of water causes the suction and mixing by venturi of different fluids.” Id. Kern evidences that the flow of a diluent in channel determines the suction action of the injectate in channel. Column 5, lines 17-28; Answer, page 5.

The Examiner concludes (Id.)

it would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the pump (37) of the Jackson reference and substitute the venturi effect as shown by Aubrey for fluids where the venturi effect is provided by the flow of water as shown by Kern for the known and expected result of being able to mix fluids in the absence of any pumps and to provide movement of the fluids to be mixed at less economical cost.

In response, while Appellant acknowledges “the general relatedness of [the cited] references,” Appellant suggests that even so, “not all elements of the present invention are disclosed as now claimed.” Brief, page 7.

To summarize, Appellant argues that Jackson depends on pumps to process the relevant fluids, that Aubrey does not teach a pumpless and valveless structure within the housing, and further that Aubrey teaches against such a structure because of needed electronic controls regulating the fluids, such as a solenoid valve. Brief, pages 8-9. According to Appellant, Kern does not teach that the flow of the disinfectant is dependent upon the flow of the biological fluid. While Appellant acknowledges that the concept of venturi and suction by water flow is disclosed, “[t]he inter-relationship

between two fluids with related venturi effects, . . . are not disclosed by the Kern patent." Brief, page 8. In addition, Appellant argues "the unique venturi-related connections and structures of the present invention cannot be found in the prior art combination when the proper analogous structures are considered." Brief, page 11.

We agree with Appellant that the Examiner has failed to establish a prima facie case of obviousness on the evidence before us. It is the Examiner's responsibility to show that some objective teaching or suggestion in the applied prior art, or knowledge generally available [in the art] would have led one of ordinary skill in the art to combine the references to arrive at the claimed invention. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996). This the Examiner has not done.

Jackson describes an apparatus for the disposal of infectious waste. Both the waste and the treatment chemical (disinfectant) enter the apparatus through the waste inlet (23). Column 5, lines 60-61. The treatment chemical is preferably a tablet but may be a liquid. Column 5, lines 62-69. Both the waste and treatment chemical are aspirated into the macerator (26). Column 5, line 17. The macerator has an inlet for a water line and a conduit through which the comminuted waste is removed by way of gravity. Column 5, lines 27-30.

While we agree that the Examiner provides evidence (Aubrey) that a venturi element in a system can remove the requirement for a pump, it is insufficient to establish obviousness to show that separate elements of the invention existed in the

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prior art, absent some teaching or suggestion, in the prior art, to combine the elements.

Arkie Lures Inc. v. Gene Larew Tackle Inc., 119 F.3d 953, 957-58, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner fails to explain why one of ordinary skill in the art would have modified the apparatus of Jackson, wherein both the waste and the treatment chemical (disinfectant) enter the apparatus in the same location and which requires the use of pumps for vacuum aspiration of the fluids, to an apparatus in which "solely a flow of water through said water flow line causes a suction action through said biological fluid line and said disinfectant line to draw a biological fluid line through said biological fluid line and draw a disinfectant through said disinfectant line so as to mix the disinfectant with the biological fluid prior to passing into said water flow line" and wherein "the suction action through said disinfectant line [is] dependent upon flow of said biological fluid."

In other words, we do not find the Examiner has shown how the apparatus of Jackson, when modified to include a venturi element, results in the claimed structure. Nor do we find that the cited references suggest the claimed relationship wherein the suction action through the disinfectant line is dependent upon the flow in the biological fluid line. Thus, it would appear that the Examiner has engaged in impermissible hindsight in making his determination of obviousness. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)("It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's

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structure as a template and selecting elements from references to fill the gaps”);
Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.
Cir. 1985).

Again, the Examiner relies on Kern to “show the concept that the flow of water causes the suction and mixing by venturi of different fluids.” Answer, page 5. Kern and Griffiths are also cited to reach the additional subject matter of dependent claims 25 and 26. We do not find that Kern or Griffiths make up for the noted deficiencies in the primary combination of Jackson and Aubrey. In view of the above, each of the rejections of the claims for obviousness is reversed.

CONCLUSION

The rejection of claims 21-25, 29-31 and 33-34 under 35 U.S.C. § 103(a) over Jackson in view of Aubrey and Kern is reversed.

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The rejection of claims 26-28, 32 and 35 under 35 U.S.C. § 103(a) over Jackson
in view of Aubrey and Kern and Griffiths is reversed.

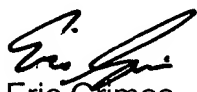
REVERSED



Toni R. Scheiner
Administrative Patent Judge



Demetra J. Mills
Administrative Patent Judge



Eric Grimes
Administrative Patent Judge

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